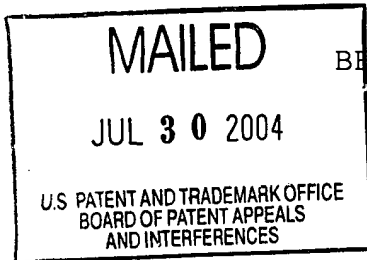


The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 18.

UNITED STATES PATENT AND TRADEMARK OFFICE



BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CARL P. TAUSSIG

Appeal No. 2004-0889
Application No. 09/716,198

ON BRIEF


Before KIMLIN, WARREN and KRASS, Administrative Patent Judges.
KIMLIN, Administrative Patent Judge.

REMAND TO EXAMINER

The present application is remanded to the examiner to provide a Supplemental Examiner's Answer and afford appellant an opportunity to respond thereto.

A principal issue on appeal is whether Miyamoto describes an optical storage medium comprising a groove having a constant angular velocity wobble within the meaning of 35 U.S.C. § 102. The examiner sets forth at page 3 of the Answer that a constant angular velocity wobbled groove is considered to be present in

Miyamoto. The examiner explains that he has interpreted claim 1 "to also include Z-CAV formatted discs - see Kobayashi et al for a discussion of Z-CAV formatted discs" (page 3 of Answer, first paragraph). However, the examiner provides no further explanation how Kobayashi's discussion of Z-CAV formatted discs is relevant to the Miyamoto disclosure. The examiner has concluded at page 6 of the Answer that Miyamoto's is a Z-CAV system, and the examiner implies that Kobayashi's discussion of Z-CAV formatted discs is evidence that the disc of Miyamoto comprises a constant angular velocity wobbled groove. However, the examiner has failed to make the requisite connection between the discussion in Kobayashi and the Miyamoto disclosure, i.e., the examiner has not indicated where, in particular, Miyamoto discloses a Z-CAV formatted disc. Nor has the examiner articulated why his interpretation of claim 1 to include Z-CAV formatted discs is valid. The examiner's implied invitation notwithstanding, it is not for the Board to ferret out the relevant disclosures, if any, in the prior art which support the examiner's legal conclusion of obviousness.



Accordingly, the examiner is instructed to set forth in the Supplemental Answer a detailed explanation regarding the evidentiary connection between the Z-CAV formatted discs of

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Kobayashi, the Miyamoto disclosure and the subject matter within the scope of claim 1.

Manifestly, appellant will be given the opportunity to respond to the elaboration found in the examiner's Supplemental Answer. In so doing, appellant may also wish to respond to the examiner's contention that Miyamoto's disc has a constant angular velocity wobbled groove because, like appellant, Miyamoto forms the disc by rotating the spindle at a constant angular velocity. We find no discussion in appellant's Brief regarding the examiner's assertion that both appellant and Miyamoto form the optical storage disc in the same manner, namely, by rotating the spindle at a constant angular velocity during the mastering of the disc (see page 4 of instant specification, last paragraph).

Concerning the examiner's rejection of claims 2, 12, 19 and 20 under 35 U.S.C. § 103, appellant should consider providing in any response to a Supplemental Examiner's Answer an additional response to the examiner's position that Aoki is not limited to a CLV system (see page 7 of Answer).

Consequently, based on the foregoing, this application is remanded to the examiner to provide a Supplemental Examiner's Answer pursuant to 37 CFR § 1.193(b)(1) (2003).

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This application, by virtue of its "special" status, requires immediate action by the examiner. See the Manual of Patent Examining Procedure, § 708.01(D) (8th ed., Aug. 2001). It is important that the Board of Patent Appeals and Interferences be promptly informed of any action affecting the appeal in this case.

REMANDED

Edward (Kurt)

EDWARD C. KIMLIN
Administrative Patent Judge

W. H. K.

ERROL A. KRASS
Administrative Patent Judge

[Signature]

CHARLES F. WARREN
Administrative Patent Judge

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Application No. 09/716,198

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